

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte TOSHIRO TSUCHIDA and TAKATSUGU NAKAZAWA

Application No. 09/986,586

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on June 21, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

A review of the Final Rejection, mailed January 21, 2004, reflects the following: Claims 7-12 were rejected under 37 CFR 101, Claims 1-3, 7-9, 13-15 and 19-21 were rejected under 35 USC 103(a) as being anticipated by Ohnuma

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et al. (Patent No. 6,375,571), Claims 4-5, 10-11, 16-17, 22-23 were rejected under 35 USC 103(a) as being unpatentable over Ohnuma et al. In view of Kondo et al (Patent No. 6,347,993), and Claims 6, 12, 18, 24 were rejected under 35 USC 103(a) as being unpatentable over Ohnuma et al. Although not applied in the rejection, the examiner made reference to Final Fantasy VIII in support of the rejection.

On April 21, 2004, appellant filed an Amendment cancelling Claims 7-12, and made the assumption that Final Fantasy VIII was being applied only in the rejection of claims 1-3, 7-9, 13-15 and 19-21. See the Advisory Action of May 14, 2004, the examiner concurred with the position of the appellant.

The Appeal Brief filed August 23, 2004, appeals the examiner's Final Rejection mailed January 12, 2004, and is based upon Final Fantasy VIII being applied in the rejection of only claims 1-3, 13-15 and 19-21.

The Examiner's Answer mailed November 12, 2004, rejects Claims 1-3, 7-9, 13-15 and 19-21 under 35 USC 103(a) as being anticipated by Ohnuma et al. (Patent No. 6,375,571) in view of Final Fantasy VIII (FFVIII); Claims 4-5, 10-11, 16-17, 22-23 under 35 USC 103(a) as being unpatentable over

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Ohnuma et al. in view of Final Fantasy VIII (FFVIII) further in view of Kondo et al (Patent No. 6,347,993); and Claims 6, 12, 18, 24 under 35 USC 103(a) as being unpatentable over Ohnuma et al in view of Final Fantasy VIII (FFVIII).

Not only should claim 7-12 not be under rejection since they were previously cancelled, but moreover, the Final Fantasy VIII (FFVIII) reference was not art previously relied on to reject the claims and thus would constitute the introduction of a new ground of rejection in the Examiner's Answer.

In summary, clarification of the 103(a) rejection for all pending claims is required.

Accordingly, it is

ORDERED that the application is returned to the examiner for resolution of the following issues:

1) vacate the Examiner's Answer dated November 30, 2004,

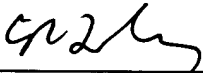
2) issue a revised Examiner's Answer setting forth all appropriate rejections and include notation of the new grounds of rejection so applied; and

3) Any further action as deemed appropriate

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

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